

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT
OF THE TTAB

7/24/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Equusport, Inc.

Serial No. 74/476,729

Equusport, Inc., pro se.

Chrisie Brightmire King, Trademark Examining Attorney, Law
Office 109 (Deborah Cohn, Managing Attorney).

Before Rice, Hanak, and Hohein, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An intent-to-use application has been filed by
Equusport, Inc. to register the mark EQUUSPORT for clothing,
namely, pants, shorts, shirts, skirts, tops, dresses,
T-shirts, sweatshirts, sweatpants, lingerie, underwear,
socks, shoes, bathing suits, hats, visors, belts, caps,
pantyhose, sandals, jackets, coats, scarves and footwear.¹

¹ Application Serial No. 74/476,729, filed January 5, 1994 under the provisions of Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b), based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant's identification of goods in the application as filed read

Registration has been finally refused under Section 2(d) of the Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its specified goods, so resembles the registered mark EQUUS, registered for men's furnishings, namely, neckwear,² as to be likely to cause confusion, or to cause mistake, or to deceive. Applicant has appealed.

In support of the refusal to register, the Examining Attorney relies upon certain definitions from *Webster's New World Dictionary* (3d col. ed. 1988). Specifically, the noun "neckwear" is defined as "articles worn about the neck, as neckties, scarfs, etc."; the adjective "sport" is defined as, inter alia, "suitable for informal, casual wear; not dressy [*a sport coat*]"; and the noun "sportswear" is defined as "clothes worn while engaging in sports or for informal, casual wear."

Applicant argues, inter alia, that "equus" is the Latin word for "horse;" that applicant uses the mark EQUUSPORT on

"clothing, footwear, headwear and accessories, including men's, women's and children's pants, shorts, shirts, skirts, tops, dresses, T-shirts, sweatshirts, sweatpants, lingerie, underwear, socks, ties, shoes, bathing suits, hats, visors, belts, caps, pantyhose, sandals, jackets, coats, scarves and all other goods in this class." The Examining Attorney issued an Office Action citing the registration which is the subject of applicant's appeal, and holding the identification of goods to be unacceptable as indefinite. Applicant amended the identification to make it definite, and also to delete the term "ties" (the goods in the cited registration being men's furnishings, namely, neckwear).

² Registration No. 1,303,812 issued November 6, 1984; affidavit Sec. 8 accepted; affidavit Sec. 15 received.

a line of women's clothing, namely, sportswear and T-shirts; that applicant currently sells these goods to specialty stores in the equestrian industry throughout the country; that names and marks with prefixes relating to the word "horse," such as "Equi," "Equa," or "Equu," are used by literally hundreds of companies doing business in the equestrian specialty marketplace; that it is unreasonable for the one root word "equus," which has spawned the language of the entire industry, to preclude other marks which reference it; that after the refusal of applicant's mark, the Patent and Trademark Office approved two other marks which include the term EQUUS, namely, BOTAS EQUUS and EQUUS IV MAN;³ that if there is no likelihood of confusion between these marks and registrant's mark, there should

³ The Examining Attorney, in her appeal brief, states that the application to register the mark BOTAS EQUUS was abandoned on June 20, 1996; that the application to register the mark EQUUS IV MAN (for men's apparel, namely, knit shirts, woven shirts, twill shorts and trousers, leather vests, and leather jackets) matured to registration on November 7, 1995; that this registration has not been made of record; and that it should not be considered by the Board. The Examining Attorney's contention that the registration should not be considered because it has not been made of record is well taken. If applicant wished to have us consider this registration, a copy thereof should have been submitted for the record prior to the filing of the appeal herein. Applicant never filed a copy of the registration, but instead merely mentioned, in its appeal brief, that the mark EQUUS IV MAN had been given approval by the Patent and Trademark Office sometime in 1995. Under the circumstances, we have given the third-party registration no consideration in our determination of this case. We add that even if the registration were properly of record, it would not change our decision herein. See, in this regard, *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *In re J.M. Originals*, 6

likewise be no concern about applicant's mark; that registrant is a manufacturer exclusively of men's neckties; that it appears that registrant is no longer selling its EQUUS neckties; that registrant's counsel has indicated that registrant would be willing to sign a letter of consent to the registration sought by applicant, but not for free; that this inherently demonstrates that registrant does not feel there is any likelihood of confusion; that the marks EQUUS and EQUUSPORT are not the same; and that the products on which they are used are completely different and are not sold in the same marketplace.

We do not find applicant's arguments persuasive. Turning first to the goods involved in this case, applicant's arguments that it actually uses its mark on a line of women's clothing, namely, sportswear and T-shirts, sold to specialty stores in the equestrian industry, while registrant is a manufacturer exclusively of men's neckties sold in a different marketplace, are to no avail, because applicant's and registrant's identifications of goods are not so limited. It is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the identification of goods set forth in the application and in the cited registration, regardless of what the record may reveal as to the

particular nature of the goods, the channels of trade in which they are sold, and the classes of purchasers to which they are sold. See, for example, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In view thereof, and because the identifications are not limited to the particular types of goods and trade channels argued by applicant, we must presume, for purposes herein, that applicant's goods include pants, shorts, shirts, etc. of all types, i.e., not just for equestrian use, and not just for women, and that they are sold through all of the normal trade channels for goods of the specified types, not just in equestrian specialty stores. Similarly, we must presume that registrant's mark is used on neckwear of all types, including neckties and scarves, and that such neckwear is made for both men and women and is sold in all of the usual and customary channels of trade for neckwear. Because registrant's identification is broad enough to encompass scarves, one of the items specified in applicant's identification, the goods of applicant and registrant must be considered to be in part

the same.⁴ Moreover, applicant's identification includes other items which are closely related to the goods set forth in the registration.⁵ For example, shirts and neckties are often bought in the same store and at the same time to coordinate with one another. As noted by the Examining Attorney, goods need not be identical or even competitive in order to support a finding of likelihood of confusion in a proceeding such as this, it being sufficient for the purpose that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that could give rise, because of the marks employed thereon, to the mistaken belief that they originate

⁴ In its reply brief, applicant indicated that it does not make ladies' scarves; that the law firm which previously represented applicant in this application sought to include as many items as possible in the event applicant's business grew to include these items; that if applicant was aware that registration was being denied due to the similarity of products, applicant would gladly amend its goods to include only "clothing, headwear and accessories, including men's, women's and children's pants, shorts, shirts, tops, dresses, T-shirts, sweatshirts, sweatpants, hats, visors, caps, jackets and coats"; that applicant does not believe this further amendment would make a difference to the Examining Attorney's refusal to register; but that if the Board feels it would, applicant would like to request a remand for the purpose; that applicant would also like a remand for the purpose of making the third-party registration of record, if necessary; but that applicant hopes a remand is not necessary, so as not to cause further delay and paperwork. Aside from the fact that the proposed identification is indefinite by reason of applicant's use of the term "including" rather than "namely," the proposed amendment and the submission of the third-party registration would not change our decision in this case. Accordingly, we have not remanded the application.

⁵ Indeed, as noted above, applicant itself originally sought registration for ties as well as for its other specified goods.

from or are in some way associated with the same source. See *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761 (TTAB 1991); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); and *In re Vienna Sausage Manufacturing Co.*, 16 USPQ2d 2044 (TTAB 1990). Because the goods (as identified) of applicant and registrant are so closely related, we find that their contemporaneous sale under the same or similar marks would be likely to cause confusion.

Turning then to the marks, we have no doubt that the term "Equus" is highly suggestive when used in connection with equestrian products. However, applicant has failed to submit any evidence in support of its argument that names and marks with prefixes relating to the word "horse," such as "Equi," "Equa," or "Equu," are used by literally hundreds of companies doing business in the equestrian specialty marketplace. Moreover, as noted above, neither registrant's nor applicant's identification is limited to equestrian use. Indeed, applicant argues that registrant's neckwear is not sold in the same marketplace as applicant's clothing products. When applied to men's neckwear sold outside of the equestrian field, EQUUS would be, insofar as the record herein shows, a strong, distinctive mark. Under the circumstances, we are not persuaded that the combination of the term "equus" and the term "sport" (which is clearly descriptive when applied to goods of the type specified in

applicant's identification) in applicant's mark EQUUSPORT results in the creation of a mark which so differs from registrant's mark as to preclude likelihood of confusion. To the contrary, we agree with the Examining Attorney that purchasers familiar with men's neckwear sold under the mark EQUUS who encounter clothing in the nature of sportswear sold under the mark EQUUSPORT are likely to believe that such clothing is a line of sport clothing emanating from the same source as the line of EQUUS men's neckwear.

Further, applicant's argument that registrant is no longer selling EQUUS neckties is of no avail because it constitutes a collateral attack upon the validity of the cited registration and as such can be entertained only in the context of a petition to cancel the registration. See *In re Dixie Restaurants Inc., supra*.

For the foregoing reasons, we find the refusal to register under Section 2(d) of the Act to be well taken.⁶

⁶ Our decision herein will not preclude applicant from filing, if it so desires, a new application to register the mark EQUUSPORT based on a different record, including evidence of third-party use of terms such as "Equus," "Equi," "Equa," or "Equu" for goods and services in the equestrian field, copies of whatever third-party registrations applicant wants to have considered, and an identification of goods which restricts applicant's specified clothing items to sale in the equestrian field.

Decision: The refusal to register is affirmed.

J. E. Rice

E. W. Hanak

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board